Supreme Court, U.S.
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No. ——

In The Supreme Court of the United States

October Term, 1998

Gilbert P. Hyatt,
Petitioner,

v.

Gary W. Boone,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Section 112, ¶ 1 of Title 35 of the United States Code provides, in relevant part, as follows:

> The specification [in a patent application] shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . .

The Question Presented in this case is:

Whether Section 112, ¶ 1 requires a patent applicant to submit a written description of his invention that, in addition to enabling one skilled in the art to make and use the invention, "necessarily" shows "possession" of the invention.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Gilbert P. Hyatt respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-17a) is reported at 146 F.3d 1348. The opinions of the Board of Patent Appeals and Interferences (Pet. App. 22a-58a) are unreported.

JURISDICTION

The judgment of the court of appeals was entered on June 17, 1998. A timely petition for rehearing was denied on August 26, 1998. Pet. App. 20a. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISION INVOLVED

Section 112, ¶ 1 of Title 35 of the United States Code provides as follows:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

STATEMENT

I. This case, like the recent decision in *Pfaff v. Wells Electronics, Inc.*, No. 97-1130, decided November 10, 1998, involves the statutory standards for establishing when an "invention" is complete for purposes of patentability. When patent claims have been altered during the course of proceedings before the Patent and Trademark Office (PTO)—whether through amendment of claims (35 U.S.C. § 132) or through the filing of a continuing application (35 U.S.C. § 120)—it is critical to determine whether such claims are supported by adequate disclosure in both the current application and any prior application for which the benefit of a prior filing date is sought. This case concerns the standards the Federal Circuit has adopted, and now made more stringent, to address that issue. As the petition contends, those standards, like the long-followed "reduction-to-practice" and "substantial completion" standards rejected in *Pfaff*, improperly add to the requirements found in the statute and lead to shifting and inconsistent tests for establishing the right to obtain a patent.

In particular, this case involves the Federal Circuit's standards for the adequacy of the "written description" that a patent applicant must provide, under 35 U.S.C. § 112, ¶ 1, to support the patent claims. The petition

asks the Court to review whether Section 112, ¶ 1 mandates that the application satisfy a "written description" requirement over and above the written description sufficient to enable the making and using of the claimed invention and, if so, what the content of that additional requirement should be. Following its controversial precedents interpreting Section 112, the Federal Circuit below reiterated that the application must meet a separate written description requirement by showing that the inventor was "in possession of" a later-claimed invention. Pet. App. 5a. The court then went on to announce a new strict standard for making that showing, declaring that the written description must be "unambiguous[]": the elements of the patent claim must be either explicit or "*necessarily* comprehended in the description provided," as "understood at the time the patent application was filed." Pet. App. 10a (emphasis added). As we discuss, *see* pages 11-25 *infra*, neither the "possession of the invention" requirement itself, nor the stringent test set forth for applying it, finds any basis in Section 112, which, instead, is satisfied as long as the description enables the making and using of the invention.

A. The issues here arise out of an interference proceeding in the Patent and Trademark Office to determine priority of invention.[1] The invention in question is a computer formed on a single integrated circuit chip, having specified circuits and functions. More particularly, the invention is as follows:

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[1] "The purpose of an interference proceeding is to resolve the question of priority of invention when more than one applicant seeks a patent on substantially the same invention." D. Chisum, 3 *Patents* § 10.09[1][a] at 10-284 (1998 ed.); *see* 35 U.S.C. § 135. The Board of Patent Appeals and Interferences (the "Board") determines "who was first to invent the common subject matter claimed in two or more applications or in one or more applications and an issued patent." *Beech Aircraft Corp. v. EDO Corp.*, 990 F.2d 1237, 1248-49 (Fed. Cir. 1993).

A computer on a chip comprising:

an integrated circuit chip having a computer implemented thereon;

(i) an integrated circuit main memory storing computer instructions, wherein said integrated circuit main memory is included on said integrated circuit chip;

(ii) an integrated circuit operand memory storing operands, wherein said integrated circuit operand memory is included on said integrated circuit chip; and

(iii) an integrated circuit processing circuit processing the operands stored by said integrated circuit operand memory in response to the instructions stored by said integrated circuit main memory, wherein said processing circuit is included on said integrated circuit chip.

The Patent and Trademark Office issued Patent No. 4,942,516 (the '516 patent) to petitioner Hyatt for this invention, which is claim 29 of the patent. Respondent Boone then copied that patent claim into his own patent application and asked the patent examiner to declare an interference. *See* note 1 *supra.* In the resulting proceeding both parties then sought to obtain the benefit of earlier-filed patent applications, seeking to establish priority from the date of those applications. *See* 35 U.S.C. § 120 (discussed, *infra,* at page 5).

The critical question, for purposes of the legal issues in this petition, was whether petitioner was entitled to the benefit of the filing date of an application, No. 05/101,881 (the '881 application), filed on December 28, 1970. That date was approximately seven months prior to the date of the earliest application for which respondent was given the benefit, an application filed on July 19, 1971. As we discuss, the Board concluded that petitioner was not entitled to the benefit of the December 28, 1970 filing date and thus was not entitled to be treated as the first inventor. Before turning to that decision, however,

we briefly set forth the statutory framework governing whether, and in what circumstances, inventors are able to claim the benefit of the filing dates of previous patent applications.

B. The statutory provision specifically addressing the issue of obtaining the benefit of prior patent applications is Section 120 of the Patent Act. That section states, in relevant part, that "[a]n application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States . . . by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application . . . ." To satisfy the conditions of Section 120, therefore, an applicant must meet the requirements of "the first paragraph of section 112."

Section 112, as a whole, sets forth the prescribed contents of the patent specification (required by 35 U.S.C. § 111). Paragraph 1 of that section provides that "[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . ." The paragraph further contains what is known as the "best mode" requirement, stating that the specification "shall set forth the best mode contemplated by the inventor of carrying out his invention." [2]

The Federal Circuit, in construing the "written description" language of Section 112, has held that it contains, in fact, two written description requirements. *See Vas-*

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[2] The decisions of the Board and the Federal Circuit were directed at the first part of paragraph one ("[t]he specification shall contain a written description of the invention" etc.), and it is that language that is addressed in this petition.

Cath, Inc. v. Mahurkar, 935 F.2d 1555 (Fed. Cir. 1991); *In re Alton*, 76 F.3d 1168 (Fed. Cir. 1996). Thus, in its view, it is not enough that the specification contain a written description sufficient to enable the making and using of the invention and set forth the best mode for carrying it out. *See Vas-Cath*, 935 F.2d at 1563-64. Rather, the court has declared that "35 U.S.C. § 112, first paragraph, requires a 'written description of the invention' which is separate and distinct from the enablement requirement." *Id.* According to the court, "the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was *in possession of the invention*." *Id.* (emphasis added).[3]

C. The Board in this case found that the specification in Hyatt's '881 application had not satisfied this second written description requirement. As a result, it found that, under Section 120, which expressly requires compliance with the first paragraph of Section 112, petitioner was not entitled to an effective filing date of December 28, 1970.

1. In making its findings, the Board rejected the argument that original Claim 40[4] in the '881 application, when read together with the disclosure in the body of the

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[3] The Federal Circuit has not limited this doctrine to cases involving Section 120. For example, the court has also held that a patent applicant adding amended claims to an original application, as provided for in 35 U.S.C. § 132, must demonstrate—in addition to enablement—"possession" of the invention defined in the amended claim as of the date of the initial filing. *See Texas Instruments, Inc. v. United States Int'l Trade Comm'n*, 871 F.2d 1054, 1062 (Fed. Cir. 1989); *see also In re Rasmussen*, 650 F.2d 1212, 1214-15 (CCPA 1981).

[4] Paragraph two of Section 112 provides that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2.

specification, fully disclosed the "[c]omputer on a chip" that was claimed in the '516 patent (and then became the subject of the interference count).[5] Original Claim 40 explicitly set forth, as the subject matter of the invention, "[a]n electronic data processing system including read only memory means, alterable memory means and program means, said system being implemented on a single integrated circuit chip." The body of the specification, moreover, set forth in detail the workings of a data processing system that included two memories—an integrated circuit read only memory that stores computer instructions, and an integrated circuit alterable scratch pad memory that stores operands[6]—as well as an integrated circuit data processor. That data processor processed operands stored in the alterable scratch pad memory in response to instructions stored in the read only memory.

The data processing system disclosed in the body of the '881 application had various novel features allowing for implementation on a single chip. Prior art systems were typically either large, expensive, "general purpose" computers that could perform a variety of tasks or smaller, less expensive, "special purpose" machines that were dedicated to specific tasks (Background of the Invention, A201-03).[7] The data processing system described in the '881 application was different: it was a general purpose computer, yet small and inexpensive enough to be dedicated to a specific task. (Summary of the Invention, A204-06).

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[5] A count defines the interfering subject matter (*i.e.*, the invention in dispute) in an interference proceeding. *See* 37 C.F.R. § 1.601(f). The single count in this case was copied exactly from Claim 29 of the Hyatt '516 patent, a claim that was written by Hyatt to describe the data processing system disclosed in the original '881 application.

[6] Operands are simply data that are operated upon.

[7] "A" refers to the Appendix filed in the court of appeals.

The basic design of the data processor, unlike most computers in the prior art, permitted the system to use an integrated circuit memory in place of a "core memory." [8] This change allowed for creation of a completely integrated circuit computer, a "monolithic computer," one that was capable of being implemented on one or more integrated circuit chips. (A210:13-19). Furthermore, unlike prior art computers, the data processor had a simple design of less than 500 logic gates (a measure of the number of electronic circuits), had limited memory requirements, had no minimum clock speed, and had a low pinout (number of wires to or from the chip). *See* A1166-67, A552-53, A649-53, A1171-77. This design permitted the system to be implemented on a *single* integrated circuit chip.

Before he filed the '881 application, petitioner completed the design of his data processing system and built prototypes using commercially available integrated circuit chips. (A516). Petitioner also talked with representatives of several chip manufacturing companies, including Texas Instruments, Intel, and General Instruments, regarding the building of a single chip computer. All of them indicated that they could implement the computer on a single integrated circuit chip. (A516-17).

2. The Board nevertheless held that petitioner had failed to meet the second written description requirement: that is, that he had failed to demonstrate "possession" of the invention as of December 28, 1970. According to the Board, a written description must be held insufficient unless, "when considered in its entirety . . . the *necessary and only reasonable construction* to be given the disclosure by one skilled in the art is one which will lend clear support to each positive limitation in the count."

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[8] A core memory was a magnetic memory using tiny doughnut shaped "cores" strung on wires to store information. As such, it could not be implemented on a single integrated circuit chip.

Pet. App. 34a (emphasis added).[9] Applying that standard, the Board held that petitioner was not entitled to the benefit of the filing date of the '881 application.

The Board acknowledged that original Claim 40 expressly claimed a data processing system "to be implemented on a single integrated circuit chip." It nevertheless decided that the data processing system disclosed in the application did not necessarily correspond to the data processing system described in the ultimately-issued patent and the interference count. The Board reasoned that "the read only memory means of claim 40 *need not* be a main memory storing computer instructions" (Pet. App. 33a) (emphasis added) and, similarly, that "the alterable memory means *need not* be an operand memory storing operands." Pet. App. 33a (emphasis added). The Board then went on to find that the "program means" in Claim 40 was not a processing circuit, Pet. App. 33a, rejecting contrary testimony—*i.e.*, that a person skilled in the art would have understood that the term "program means" referred to a processing circuit—on the ground that the testimony failed to "address[] whether a data processing system must *necessarily* include the specific processing circuit required by the ['516 patent and, hence, the interference] count." Pet. App. 34a (emphasis added).[10]

II. The court of appeals affirmed. It recognized that, under Section 120, petitioner was entitled to the benefit of the filing date of the '881 application provided that

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[9] A "limitation" is terminology that narrows or limits a patent claim or interference count.

[10] The Board did not decide whether the '881 application "enabled" skilled persons to make and use the invention, ruling only that petitioner had not been estopped by an earlier decision, *In re Hyatt*, No. 87-1597 (Fed. Cir. June 9, 1988) (unpublished opinion), from establishing enablement before the PTO. Subsequent to the 1988 decision, petitioner submitted additional evidence regarding enablement to the PTO, ultimately overcoming any objection on grounds of enablement and obtaining the '516 patent.

the application met the statutory requirements of Section 112, ¶ 1. Adhering to circuit precedent, however, it continued to declare that Section 112, ¶ 1 contained (in addition to the best-mode requirement) a two-part burden for inventors to meet. According to the court, "[t]he earlier application must contain a written description of the subject matter of the interference count *and* must meet the enablement requirement." Pet. App. 5a (citing *Fiers v. Revel*, 984 F.2d 1164, 1170 (Fed. Cir. 1993) (emphasis added)).

As it had in the past, the Federal Circuit stated that, to satisfy its separate "written description" requirement, an inventor had to demonstrate that he was in "possession" of the invention at the claimed filing date. Pet. App. 7a-8a (patent application "must describe the subject matter of the count in terms that establish that he was in possession of the later-claimed invention, including all of the elements and limitations presented in the count, at the time of the earlier filing"). The court then went on to address what standard that showing of "possession" had to meet. Like the Board, the court made clear that the standard was a demanding one, stating that, "when an explicit limitation in an interference count is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description *requires* that limitation." Pet. App. 8a (emphasis added). *See also* Pet. App. 8a (quoting *Martin v. Mayer*, 823 F.2d 500, 505 (Fed. Cir. 1987) ("question [is] whether the application *necessarily* discloses that particular device") (emphasis added)). The court thus declared insufficient any specification "that does not *unambiguously* describe all limitations of the count." Pet. App. 8a (emphasis added).

The court of appeals turned aside arguments that this heavy burden was inconsistent with proper standards under Section 112. The court agreed that Federal Circuit

cases had previously used various phrases to describe the burden needed to satisfy the "possession" test—including some that, by their terms, seemed to require less certainty than the " 'necessary and only reasonable construction' " standard applied by the Board—but declared that, in the end, it did "not view these various expressions as setting divergent standards for compliance with § 112." Pet. App. 10a. The court then announced what it saw as the governing standard: "[T]he written description must include all of the limitations of the interference count, or the applicant must show that any absent text is *necessarily* comprehended in the description provided and would have been so understood at the time the patent application was filed." Pet. App. 10a (emphasis added). Following this test—that a written description does not convey possession of the invention unless it explicitly or necessarily does so—the court of appeals held that "[t]he Board did not clearly err in finding that Hyatt did not establish in the '881 application's written description that he possessed the entire subject matter of the count." Pet. App. 10a.

REASONS FOR GRANTING THE WRIT

The issues in this case arise out of the Federal Circuit's serious misreading of Section 112, ¶ 1 of the Patent Act, a critical statutory provision for determining whether an inventor is entitled to a patent for his invention. That section states, in relevant part, that "[t]he specification [in a patent application] shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . ." 35 U.S.C. § 112, ¶ 1.[11]

[11] As noted above, *see* pages 4-6 *supra*, the issue arises in this particular case because of the interplay between Section 112 and Section 120, which states that "[a]n application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the

This language could hardly be clearer: a patent applicant, in order to satisfy the written description requirement of Section 112, ¶ 1, must simply submit a written description of his invention that is sufficient to allow a skilled artisan to make and use that invention.

Notwithstanding this commendable clarity, the Federal Circuit has arrived at two striking determinations. First, it has announced—in the face of wording seeming to say just the opposite—that, to meet the terms of Section 112, it is *not* enough for an inventor to provide a written description "in such full, clear, concise, and exact terms as to enable" the making and using of the invention. Rather, in its view, a written description must also show, in words not found anywhere in the statute, that the inventor was "in possession of" the invention at the time of filing. *See* Pet. App. 5a; *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991). Second, the court has held that its non-statutory standard can be met only by demonstrating that the claimed invention was either explicitly or "necessarily" comprehended in the prior written description. Under that standard, a written description is insufficient even though one skilled in the art would recognize that the specification—giving it a reasonable (though not the only possible) reading—adequately disclosed the subject matter of the invention.

These additional, ever-increasing hurdles for patent applicants simply cannot be squared with the statutory provisions enacted by Congress. *See Pfaff v. Wells Electronics, Inc.*, No. 97-1130, decided November 10, 1998, slip op. at 7 (rejecting judicially-created standard with "no basis in the text" of relevant statutory provision). Nothing in Section 112, ¶ 1 requires a showing—on top of a showing sufficient to enable the making and using of the invention—that the inventor was "in possession of"

United States . . . shall have the same effect, as to such invention, as though filed on the date of the prior application . . . ." 35 U.S.C. § 120.

the invention, much less that he or she was "necessarily" in possession of it. Indeed, this Court in *Pfaff* has recently made clear that proof of enablement *by itself* is sufficient to demonstrate that an invention has been fully conceived and is "ready for patenting," slip op. at 11-13, a determination that would seem to inform the proper construction of Section 112, ¶ 1 as well. Furthermore, as critics have rightly observed, the possession-of-the-invention requirement leads to a largely standardless inquiry, producing a series of *ad hoc* judgments without any coherent rhyme or reason. It thus presents a formidable, yet indistinct, barrier to inventors seeking to comply with the filing requirements of the Patent Act.

The proper construction of Section 112 is a matter of considerable importance to the sound working of the patent system. Although the Federal Circuit has made clear that its additional requirement is of significance only for amended claims, *see* pages 22-25 *infra*, it is common practice for patent applicants to file successive applications, or otherwise to amend their claims, during the course of proceedings before the Patent and Trademark Office, and the right to obtain a patent thus will often turn on what support Section 112 requires for such claims. According to Federal Circuit doctrine, however, an application will not support a claim unless the application contains—in addition to an enabling description—a description "necessarily" showing "possession" of the invention, despite the fact that an enabling description alone is enough to show that an invention is complete (and to start the clock running against an applicant) for purposes of other statutory provisions. *See Pfaff*, slip op. at 11-13. This extra-statutory condition not only will wrongfully deny patents to applicants relying on otherwise complete applications but will create a needless burden on future applicants seeking to draft specifications to anticipate what the Federal Circuit might someday deem enough to show "possession" of a later-claimed invention. This judicial recasting of the

patent system should not be allowed to proceed without review by this Court.

I. A. The decision of the Federal Circuit in this case has further tilted the balance against inventors seeking to obtain patent protection, holding that their applications will not satisfy the written description requirement of Section 112 unless they expressly or "necessarily" encompass the subject matter of the claimed invention. As we discuss below, *see* pages 19-22 *infra*, that standard, even viewed in isolation, calls for a degree of certainty that is wholly out-of-place in the prosecution of patent applications. What makes the standard even worse, however, is that it increases the difficulty of meeting a requirement—the possession-of-the-invention requirement—that is not in Section 112 in the first place. Thus, as the burdens imposed on patent applicants mount, the scheme created and enforced by the Federal Circuit bears less and less relationship to the statutory scheme enacted by Congress.[12]

The central point of demarcation is a relatively recent series of decisions by the Federal Circuit (and its predecessor, the Court of Customs and Patent Appeals) announcing that Section 112, ¶ 1 contains a written description requirement *in addition to* the familiar requirement that a patent specification contain a description sufficient to enable the making and using of the invention at issue.

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[12] The new written description requirement devised by the Federal Circuit only affects the patentabiilty of *amended* claims. *See* D. Chisum 3 *Patents* § 7.04 at 7-137 (1998 ed.) ("[t]he description requirement comes into play when a claim is added by an applicant for a patent at some stage after the original filing date and the claim differs in scope from the original claims"). By contrast, it is always the case that "an 'original claim,' that is, one contained in a patent specification when it is filed, complies with the Section 112 invention description requirement." D. Chisum, 3 *Patents* § 704[1][c] at 7-152 (1998 ed.). That is because "original claims constitute their own description," *In re Koller*, 613 F.2d 819, 823-24 (CCPA 1980), and thus by definition show "possession" of the invention they describe. *See* pages 22-25 *infra*.

See, e.g., Vas-Cath, 935 F.2d at 1555; *In re Barker*, 559 F.2d 588 (CCPA 1977), *cert. denied*, 434 U.S. 1064 (1978); *In re Ruschig*, 379 F.2d 990 (CCPA 1967). As one commentator has observed, "[t]he notion of the *description* requirement as separate and distinct from the *enablement* requirement of 35 USC 112 may be analogized to a UFO, first identified in 1967, fifteen years after launch and confirmed by the early 1970s." Pitlick, *Looking Beyond Blazemarks on Trees—It's Time To Revisit the Description Requirement in the Wake of Warner-Jenkinson*, 79 J. Pat. & Trademark Off. Soc'y 625, 628-29 (1997). Although the Federal Circuit appeared for a time to be backing away from its idea of a second written description requirement, *see Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F.2d 1419, 1421 (Fed. Cir. 1987), *cert. denied*, 486 U.S. 1008 (1988) ("[t]he purpose of the description requirement of this paragraph is to state what is needed to fulfill the enablement criteria"), it now appears that, insofar as the Federal Circuit is concerned, the requirement is here to stay. A few years ago, the Court in *Vas-Cath* expressly sought to eliminate "some confusion in our decisions" (935 F.2d at 1563) by reaffirming "that 35 U.S.C. 112, first paragraph, requires a 'written description of the invention' which is separate and distinct from the enablement requirement." 935 F.2d at 1563. This novel requirement—"born in mysterious circumstances, abused during its adolescence, and now a wayward adult" (Rhoades, *The Section 112 "Description Requirement"—A Misbegotten Provision Confirmed*, 74 J. Pat. & Trademark Off. Soc'y 869, 902 (1992)—thus will continue to serve as an obstacle to patent applicants otherwise in compliance with the requirements of Section 112.

Given that the various Patent Acts have contained a written description requirement for more than 200 years, it is not surprising that the belated discovery of a second "separate and distinct" requirement has engendered considerable skepticism. *See* R. Merges, *PATENT LAW & POLICY* 713 (2d ed. 1997) ("[t]here has been dispute

concerning the written description requirement since its refinement and reemergence in the CCPA"). Although the Federal Circuit insists that Section 112 calls for a description showing that the inventor was "in possession of the invention," *Vas-Cath*, 935 F.2d 1564, the language of Section 112, ¶ 1 gives no hint of the need for any such showing. Naturally read, the relevant part of paragraph one calls for nothing more than a written description "in such full, clear, concise, and exact terms as to enable" the making and using of the invention. *See Wood v. Underhill*, 46 U.S. (5 How.) 1, 5 (1847) (description must be "so full, clear, and exact as to enable any one skilled in the art to compound and use it"); *Beidler v. United States*, 253 U.S. 447, 453 (1920) (same); *Smith v. Snow*, 294 U.S. 1 (1935) (same). Indeed, the contrary view adopted by the Federal Circuit is derived only by reading into the statute a grammatical absurdity: that the subsequent words "in such full, clear, concise, and exact terms as to enable" do not modify the phrase "a written description of the invention" at all, but relate solely to the *parenthetical* phrase "and of the manner and process of making and using it." As a matter of statutory construction, therefore, the requirement created by the Federal Circuit runs head-on into the plain meaning of the crucial language.

The statutory history of Section 112, likewise, belies any notion that it requires a separate showing of "possession" of the claimed invention. It is true that an earlier version of Section 112 once contemplated that the written description of the invention would serve two distinct purposes. Thus, the 1793 Patent Act provided that an inventor must "deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms" as, *first*, "to distinguish the same from all other things before known" and, *second*, "to enable any person skilled in the art or science, of which it is a branch, or with which it is most nearly connected, to make, compound,

and use the same." Patent Act of 1793, Sec. 3. *See also Evans v. Eaton*, 20 U.S. (7 Wheat.) 356 (1822). But this historical evidence of dual purposes offers no support for the requirement now recognized by the Federal Circuit. Quite apart from the fact that the language was dropped from the statute in 1836, and has not been revived,[13] the additional purpose contemplated by the 1793 Act ("distinguish[ing] the same from all other things before known") had nothing whatsoever to do with the idea of demonstrating "possession" of the invention. Thus, whether one looks at the language of Section 112 or its historical pedigree, it remains apparent that the Federal Circuit, following the lead of the Court of Customs and Patent Appeals, has fashioned its new requirement out of thin air. *See Pfaff*, slip op. at 7 (rejecting court of appeals' standard "with no basis in the text").

Its uncertain statutory moorings aside, *see* Rhoades, *supra*, at 870-73, the separate written description requirement has been subjected to a number of other telling criticisms. Most colorfully, Judge Markey, "heartily" dissenting in *In re Barker*, noted the peculiarity of deciding that an inventor who has enabled others to make and use his invention is somehow not himself in possession of that same invention, stating: "How incongruous. How exaltive of form over substance." 559 F.2d at 594.[14] That

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[13] The function of distinguishing the invention from "things before known" is now fulfilled by the language of the claims. The 1836 Act was the first patent statute to require the inventor to specify the subject matter of the invention. *See* D. Chisum, 3 *Patents* § 8.02[2] at 8-7 (1998 ed.). The 1870 Act subsequently incorporated a requirement that the inventor "claim" his invention. *Id. See Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384, 1390 (1996).

[14] Judge Markey pointedly noted that "disclos[ing] an invention in such 'clear, concise and exact terms' (enablement) as to enable its practice [was] the very purpose and quid pro quo of the patent system from its inception." 559 F.2d at 594. *See also* Merges, *supra*, at 714 (pointing out that "the regular enablement requirement seeks to relate patent scope to the underlying value of the patentee's disclosure").

counter-intuitive notion might make sense, perhaps, if an inventor could satisfy the enablement requirement with merely a bare-bones description, forcing skilled artisans to go to extraordinary lengths to make and use the invention; but it is well established that the enablement requirement is not met if one skilled in the art has to resort to undue experimentation. *See* D. Chisum, 3 *Patents* § 7.03 at 7-10 (1998 ed.); *Minerals Separation v. Hyde*, 242 U.S. 261 (1916). The Federal Circuit has thus created an illogical body of law under which persons of ordinary skill are deemed able to make and use the invention without undue effort but the inventor, who instructed them how to do so, is nevertheless not entitled to claim that invention as his own.

This Court, by contrast, has just strongly reaffirmed that a written description enabling the making and using of an invention is ample proof that the inventor has sufficiently conceived of it. *See Pfaff*, slip op. at 11-13. In *Pfaff* the Court stressed that "[t]he word 'invention' must refer to a concept that is complete, rather than merely one that is 'substantially complete.'" Slip op. at 11. Noting that "one can prove that an invention is complete and ready for patenting before it has actually been reduced to practice," slip op. at 11, the Court then specifically pointed to a form of proof that would be sufficient: "proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention." Slip op. at 12. But if proof of enablement is enough to show that "an invention is complete and ready for patenting," there is no justification for contriving a further nontextual requirement, over and above that of enablement, to deny the inventor a patent for that invention.

Equally troubling is the fact that the possession-of-the-invention requirement is bereft of any meaningful content. *See* Rhoades, *supra*, at 893 (describing standard as

"unduly vague and 'subjective' "); Pitlick, *supra*, at 635 (noting "difficulty of determining precisely what the inventor *possessed* at the time in question"). This lack of content leads to several distinct, though related, problems. Naturally enough, it leads to decisions, sometimes finding "possession," sometimes not, without any coherent pattern or principle. *See* Rhoades, *supra*, at 870 ("since the 'description requirement' lacks a firm mooring in the language of the statute or its underlying purposes, many of the decisions applying the requirement seem unprincipled or misguided"); Walterscheid, *Insufficient Disclosure Rejections (Part III)*, 62 J. Pat. Off. Soc'y 261, 282 (1980) ("whether there is adequate description of the invention is frequently more subjective than the C.C.P.A. would care to admit"). That incoherency, in turn, puts inventors in the awkward position of trying to draft, or defend, patent applications to meet an essentially amorphous test. These difficulties all arise inevitably from the need to apply a rootless standard "that requires disclosure beyond that of the ordinary enablement requirement of § 112, and yet short of a requirement of actual claiming." Merges, *supra*, at 714.[15]

B. The decision below aggravates the problems provoked by a free-floating "possession" requirement by holding, in essence, that all doubts about possession are to be resolved against the inventor. Although the court of appeals paid lip service to the straightforward test urged by petitioner—whether the disclosure "reasonably conveys to the artisan" that the inventor had possession of the subject matter, *see* Pet. App. 10a—it effectively read the word "reasonably" out of that test, substituting instead a strict standard for determining whether possession had been conveyed: "[T]he written description must include all of the limitations of the interference count, or the ap-

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[15] Even the Federal Circuit has conceded that "the precedential value of cases in this area is extremely limited." *Vas-Cath*, 935 F.2d at 1562 (quoting *In re Driscoll*, 562 F.2d 1245, 1250 (CCPA 1977)).

plicant must show that any absent text is *necessarily* comprehended in the description provided and would have been so understood at the time the patent application was filed." Pet. App. 10a (emphasis added). This standard was fully in keeping with the earlier admonition by the court that a description must "unambiguously describe[] all the limitations of the count." Pet. App. 8a. The court thus was able to uphold the Board finding that petitioner had not demonstrated possession of his invention.[16]

The new standard adopted by the Federal Circuit, like the possession-of-the-invention requirement itself, finds no apparent basis in the language of Section 112. The only possibly applicable language—that the written description be in "full, clear, concise, and exact terms"—relates, of course, specifically to the requirement that the description enable the making and using of the invention, a part of paragraph one that the Federal Circuit regards as separate and distinct from the "possession" requirement. Even if that language were borrowed, however, it would not support the notion that a written description must unambiguously or necessarily show possession of the invention. In the context of enablement, the words "in full, clear, concise, and exact terms" do *not* mandate a description that "necessarily" or "unambiguously" leads to the making and using of the invention. Instead, it is sufficient that one skilled in the art, applying his knowledge, can make and use the invention without undue trial and error. *See* page 18 *supra*.

A comparable standard should apply here. Although a written description may be susceptible to several imaginable readings, there is no good reason—at least, the Federal Circuit has offered none—to resolve all doubts against

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[16] Although the court did not disavow the language relied on by petitioner, it nevertheless held that a written description, by law, could not convey possession unless it met the newly-announced standard. Pet. App. 10a. It then affirmed the decision of the Board, which had held that the description had to meet a strict "necessary and only reasonable construction" standard. Pet. App. 34a.

the inventor. On the contrary, if a second written description requirement is to be applied at all, it seems most natural to inquire whether, applying normal burdens of proof, the description reasonably conveys to one skilled in the art that the inventor was in possession of the invention at the relevant time. *See Minerals Separation v. Hyde*, 242 U.S. at 270 ("the certainty which the law requires in patents is not greater than is reasonable, having regard to their subject matter"). So long as that standard is met, then the written description has satisfied the vital purpose of apprising the public of "new and useful advances in technology." *Pfaff*, slip op. at 8. The fact that the description might possibly be read to convey other inventions as well does not mean that the inventor has failed to make adequate disclosure of his claimed invention.

The mischief worked by refusing to read the written description in a reasonable light can be readily seen in this case. The Board acknowledged that original Claim 40 in the '881 application—on its face, highly similar to the count at issue in the interference proceeding—*might* describe a data processing system with two memories and a processing circuit, all "implemented on a single integrated circuit chip." Pet. App. 33a. Applying its "necessary and only reasonable construction" standard, however, it went on to find that "the read only memory means of claim 40 *need not* be a main memory storing computer instructions and the alterable memory means *need not* be an operand memory storing operands." Pet. App. 33a (emphasis added). By the same token, it found that the "program means" in original Claim 40 was not the processing circuit of the count, saying that contrary testimony (that those skilled in the art would recognize that the term referred to a processing circuit) had failed to address "whether a data processing system must necessarily include the specific processing circuit required by the count." Pet. App. 34a; *see also* Pet. App. 34a ("[t]he 'program means' as an alleged processing circuit *does not*

have to operate on operands stored in an on-chip memory") (emphasis added) Even if those speculative readings were plausible—a doubtful proposition because, among other things, they construe the claim as involving a data processing system without a data processor—they do little to answer the proper question: whether the claim language and the body of the specification, considered together, would disclose the invention to one skilled in the art.

Like burdens of proof, *see generally Addington v. Texas*, 441 U.S. 418, 423 (1979), the standard chosen for assessing written descriptions ultimately allocates where the risk of particular determinations must lie. By resolving any ambiguity against an inventor, the Federal Circuit has apparently decided that it is sound policy to deny patents to inventors whose applications likely, but not necessarily, comprehend the subject matter of their claims. But the basis for this choice is unstated, and, given efforts by Congress to stimulate inventive activity, the basis for the choice is hardly clear. In our view, even assuming that a distinct possession-of-the-invention requirement exists at all, it is far more consistent with the requirements of Section 112 in particular, and with the objectives of the Patent Act as a whole, to award the benefits of patent protection to an inventor as long as the submitted written description, reasonably read, disclosed the invention to those skilled in the art at that time.

C. The Federal Circuit has indicated that its separate written description requirement is intended to protect against "overreaching" by inventors filing amended claims. *See Vas-Cath*, 935 F.2d at 1561 (quoting *Rengo Co. Ltd. v. Molins Mach Co.*, 657 F.2d 535, 551 (3d Cir.), *cert. denied*, 454 U.S. 1055 (1981) ("possession" requirement " 'guards against the inventor's overreaching by insisting that he recount his invention in such detail that his *future* claims can be determined to be encompassed

within his original creation.' ") (emphasis added)). *See also In re Smith*, 481 F.2d 910, 914 (CCPA 1973); *In re Wright*, 866 F.2d 422 (Fed. Cir. 1989). But there are several obvious problems with this attempted rationale. To begin with, it simply does not fit with the language and structure of Section 112, which gives no indication of a legislative concern about, or hostility to, amended claims. Rather, the requirements expressly set forth in Section 112 (the enablement and best mode requirements) apply in equal measure to all claims, amended or not. It is thus quite wrong to read Section 112 as embodying an on-again, off-again requirement that, at bottom, makes the right to obtain a patent depend on whether the claimed invention is defined in an original or an amended claim.[17]

The disfavored treatment given to amended claims is out-of-place for another reason as well. Whether or not concerns about amendment of claims are well-founded, *see, e.g.*, Marcus, *Is the Submarine Patent Torpedoed?: Ford Motor Co. v. Lemelson and the Revival of Continuation Application Laches*, 70 Temple L. Rev. 521, 524-27 (1997),[18] the fact remains that the right to alter the originally filed claims—without loss of the original filing

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[17] The Court of Customs and Patent Appeals has described several circumstances in which the requirement is implicated, stating that "[t]his concept applies whether the case factually arises out of an assertion of entitlement to the filing date of a previously filed application under § 120 . . . or arises in the interference context wherein the issue is support for a count in the specification of one or more of the parties . . . or arises in an ex parte case involving a single application, but where the claim at issue was filed subsequent to the filing of the application." *In re Smith*, 481 F.2d at 914.

[18] *But see* Marcus, *supra*, at 583 ("[*State Industries, Inc. v. A.O. Smith Corp.*, 751 F.2d 1226 (Fed. Cir. 1985)] announced that there is nothing improper or illegal about one competitor attempting to exclude another's product from the market when that product is merely an embodiment of the invention disclosed but unclaimed in its pending patent application").

date—is provided for in the Act. Section 120, by its express terms, allows for the filing of more than one application, with later applications entitled to the filing date of earlier ones so long as they meet the stated conditions (including compliance with the first paragraph of section 112). Likewise, Section 132, addressing rejection of (or objections to) patent claims, contemplates that an applicant may amend his application, so long as he does not "introduce new matter into the disclosure of the invention." Against this background, the Federal Circuit lacks the authority to impose additional conditions on the rights extended by Congress, either by announcing extra-statutory conditions as such or, as here, by reading into the statute conditions that are not there. *See Pfaff*, slip op. at 8 (rejecting "nontextual argument").[19]

The burdens added by the Federal Circuit are even more inappropriate because Congress itself has given substantial recent attention to issues arising out of prolonged patent prosecutions, including the amendment of claims. Most notably, Congress has decided that patents issued on applications filed on or after June 8, 1995 will have a life of 20 years, *less* the time that applications for the patents were in prosecution. *See* 35 U.S.C. § 154 (West Supp. 1995). That modification has been criticized as inadequate to eliminate all difficulties caused by amendment of claims, *see* Marcus, *supra*, at 525-26, but it clearly shows that Congress is able to address for itself any perceived malfunctions in the patenting process. If Congress believes that the provisions allowing for amendments to patent applications are too lenient in some way, it can elect to amend Sections 120 and 132, or, for that matter,

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[19] Professor Chisum has noted that the Federal Circuit appears to be using the possession-of-the-invention requirement to serve some of the purposes once served by the also non-statutory, and now largely abandoned, "late claiming" doctrine. D. Chisum, 4 *Patents* § 11.05 at 11-260 (1998 ed.). *See Muncie Gear Works, Inc. v. Outboard, Marine & Mfg. Co.*, 315 U.S. 759 (1942).

amend Section 112 to include additional requirements. To date, however, it has not done so.

Finally, even leaving aside questions of authority, it is simply not clear why Section 112 as written—that is, prior to judicial discovery of a separate possession-of-the-invention requirement—was inadequate to deal with any "overreaching" arising out of the amendment of claims. By any reading, Section 112 already mandates that the original written description be in such "full, clear, concise, and exact terms as to enable" the making and using of the invention defined in the claims at issue (including, of course, the invention defined in any amended claim). Provided that the written description satisfies *that* requirement, what is the objection to recognizing that the inventor has a valid claim to the subject invention? As one commentator has stated, "[a] description of the invention, and the manner of using it, in terms sufficient to enable the artisan to make and use it, provides strong evidence that the inventor has fully grasped, and is therefore entitled to claim as his or her own invention, the subject matter claimed." Rhoades, *supra*, at 897. Indeed, the idea that enablement is *not* enough seems flatly contrary to the view just expressed by this Court, in a related context, that an invention is complete and "ready for patenting" when the inventor provides a description that is "sufficiently specific to enable a person skilled in the art to practice the invention." *Pfaff*, slip op. at 12.

II. The issues in this case are of substantial importance to the proper administration of the Patent Act. Most patent applications involve amendments to the claims, and it is often necessary to determine what filing date should be accorded to the amended claims.[20] Yet,

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[20] As Professor Chisum has stated: "[t]he filing date of an application for a patent is critical because of the statutory bar provisions . . . . It is also the prima facie invention date for determining novelty, priority, and nonobviousness." D. Chisum, 3 *Patents* § 7.04 n.6, at 7-137 (1998 ed.).

as a result of the extra-statutory doctrine crafted by the Federal Circuit, a patent applicant faces a strange contradiction: although this Court regards an enabling description as sufficient in and of itself to show that an invention is "complete and ready for patenting," *see Pfaff*, slip op. at 11-13, the Federal Circuit regards an enabling description as *in*sufficient to show "possession" of the invention at the time of description. Not only is this dissonance illogical—how can an inventor have a complete concept of his invention and yet not be in possession of it?—but it produces dual standards when a single standard for marking the time of complete invention would be both clearer and more fair.

The obstacles created by the Federal Circuit also have serious practical repercussions for patent applicants. Most particularly, applicants like petitioner, who are relying on previously filed applications, will be denied patents to which they would be entitled under the statute as Congress seemingly has written it. This case provides a stark example: although a person skilled in the art (using the disclosure in the '881 application) could make and use a data processing system implemented on a single chip without any undue experimentation, *see* note 10 *supra*, and although this skilled person would reasonably conclude that petitioner himself had possession of that invention at the time, the cumulative standards developed by the Federal Circuit for applying Section 112 have deprived petitioner of his patent for that invention. And this case is not unusual: the court of appeals maintains the power to bring about such denials in any case in which it decides, after the fact, that an applicant has not shown possession with the certainty now called for by its newly announced test.

The burdens on future patent applicants will also be increased. An inventor or a patent lawyer, undertaking the already difficult task of drafting patent applications, now has the responsibility to draft a specification so free

of ambiguity that, by "necessary construction," Pet. App. 10a, it will be seen to convey possession of an invention to be defined in later, yet-to-be drafted claims.[21] And he or she must undertake that responsibility having been told that a description sufficient to enable the making and using of that invention is not enough, but not having been told what would be enough. The natural effect will be to force the drafting of applications that are increasingly prolix, in an effort to cover all the possible bases on this increasingly-tilted playing field. Indeed, inventors may ultimately become more reluctant to seek patent protection, or expend money on research and development, when patent rights depend on the uncertainty of predicting just what description will later be regarded as sufficient to show possession of a particular invention.

There is, in the end, no sound basis for requiring patent applicants to shoulder these added burdens. The Federal Circuit has impermissibly distorted the statutory scheme enacted by Congress, and review by this Court is warranted.

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[21] The Board in this case did not dispute that the written description in the '881 application could have *included* the invention in issue; rather, it found that the description did not necessarily *exclude* other possible inventions. Pet. App. 33a-35a. It seems an especially onerous task, however, to require an inventor to describe both what he considers to be his invention and what he considers not to be his invention.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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